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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,533	09/19/2006	Shinichi Ogasawara	SCEP 22.456(100809-00319)	5458
26304 7590 05/05/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER CHERIYAN JR, THOMAS K	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 05/05/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,533	<b>Applicant(s)</b> OGASAWARA ET AL.	
	<b>Examiner</b> THOMAS K. CHERIYAN JR	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/24/2006; 4/19/2006; 7/17/2006; 4/27/2006;</u>               | 6) <input type="checkbox"/> Other: _____                          |
| <u>8/9/2006; 9/18/2006; 1/18/2006.</u>   |   |



## DETAILED ACTION

### *Objections*

Claim 7 is objected to because of the following informalities: The word “daring” should be spelled as “during”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oshita (US 20020047237 A1) in view of Tomizawa (JP 2001104645 A).

Regarding claim 1, Oshita discloses a portable electronic device, comprising;

a horizontally long casing, both ends of which are capable of being gripped by a user's both hands, respectively, **(Obvious. Oshita, Figure 4 clearly shows a person holding a portable electronic device with two hands)** and

a display unit fit into the casing **(Obvious. Oshita, Figure 3, LCD Display 4)**, wherein outwardly projecting bulges are respectively formed at both sides of the rear face of the casing where fingers of the user gripping the casing placed **(Obvious. Looking at Oshita, Figures 2, 3, and 4, we can see bulges at the rear of the case which enables a person to place their fingers behind the portable electronic device.)**.

Regarding claim 2, Oshita discloses the planar region is provided between the two bulges on both sides of the rear face of the casing, at least part of the planar region being a lid of a disk drive unit **(Obvious, Oshita, Figures 2, 3, 4.)**.

Regarding claim 3, Oshita discloses the outer edge of each side of the casing is formed as are shape fitting to the curve formed by a palm of the user gripping the casing **(Obvious. Oshita, Figures 2, 3, 4.)**.

Regarding claim 4, Oshita discloses a horizontally longitudinal cross section of the casing has a gentle curve slanted from the center of the casing to the left or right hand of the user **(Obvious. Oshita, Figure 3 shows a gentle curve and the left and right side of the casing.)**.

Regarding claim 5, Oshita discloses further comprising a first operation means and a second operation means provided on the front face of the casing,

wherein each of the first operation means and the second operation means is operated by a thumb of the user gripping the casing **(Obvious)**,

the first operation means is a direction instruction key having a plurality of pressed faces each corresponding to an operation direction **(Obvious. Oshita, Figure 3 shows two direction pads on the left side of the device.)**,

the second operation means is a plurality of button keys each outputting single instruction **(Obvious. Oshita, Figure 3 shows a plurality of buttons on the bottom and right side of the device.)**, and

the center of the direction instruction key and the center of the button keys are shifted upward in the vertical direction from the horizontal center line of the casing when viewed from the user **(Obvious, Figure 3)**.

Even though Oshita discloses that the device has plurality of keys and a direction key pad, Tomizawa (JP 20011047645 A) also discloses a portable device with this type of button layout, also specifically showing that the direction keypad and the button keys are shifted upward **(Tomizawa, Figures 1B and 3A)**.

The motivation for combining the teachings of Tomizawa with Oshita is because both are portable electronic devices for use with gaming and Tomizawa simply illustrates that the button and direction pad are shifted upwards towards the device respectively.

Therefore, it would be obvious to anyone skilled in the art of gaming at the time of the invention to combine the teachings of Zomizawa with Oshita to have the direction

pad and buttons shifted upward because it would be more comfortable for a player to control the controls with during gameplay.

Regarding claim 6, Oshita and Tomizawa disclose when the casing is placed on a horizontal plane so that a face without the display unit is oriented downward, a top of the direction instruction key and a top of any one of the plurality of button keys are higher than the maximum height of the casing.

Oshita and Tomizawa do not disclose or show a plurality of buttons on the top of electronic game device, however, Ku (US 6530570 B2) does **(Ku, Figure 1, Top Buttons 12 and Column 1, Lines 20-27.)**.

The motivation for combining the teachings of Ku with Oshita and Tomizawa is because all of them are portable electronic gaming devices except that Ku adds more inputs to the top of the gaming device.

Therefore, it would be obvious to anyone skilled in the art of gaming at the time of the invention to combine the teachings of Ku to add a plurality of buttons to the top part of the electronic game device because it would allow for a player to have a better selection of inputs during gameplay.

Regarding claim 7, Oshita, Tomizawa, and Ku disclose the front face of the casing comprises at least two areas,

the direction instruction key and the plurality of button keys are placed in a first area **(Obvious)**, and

at least one sub operation button not used during game play going on the display unit is placed in a second area **(Obvious. It would be obvious during gameplay of a game that not all the inputs of the electronic game device will be used.)**,

wherein the height of the first area and the height of the second area are different from each other when measured from a horizontal plane on condition that the casing is placed on the horizontal plane so that a face without the display unit is oriented downward **(Obvious)**.

Regarding claim 8, Oshita, Tomizawa, and Ku disclose the second area is elevated from the first area **(Obvious)**.

Regarding claim 9, Oshita, Tomizawa, and Ku discloses spacing between the pressed surfaces of the direction instruction key and spacing between each button of the button keys are different from each other **(Obvious)**.

Regarding claim 10, Oshita, Tomizawa, and Ku disclose further comprising an analog operation means for outputting an analog signal for direction, wherein the analog operation means is location closer to the user than the direction instruction key and the center of the analog operation means is located inside of the center of the direction instruction key.

Oshita, Tomizawa, and Ku do not disclose using an analog operation means for outputting an analog signal for direction, however, DeVolpi (US 5912612) does **(DeVolpi, Abstract)**.

The motivation for combining the teachings of DeVolpi with Oshita, Tomizawa, and Ku is because DeVolpi teaches that the analog input can be used in conjunction



with video games and consumer electronic such as the ones described by Oshita, Tomizawa, and Ku. It would also be obvious that since the portable electronic device such as the ones described by Oshita, Tomizawa, and Ku already have a plurality of inputs, it would be obvious to implement this type of input as well.

Therefore, it would be obvious to anyone skilled in the art of gaming at the time of the invention to add an analog input as well in conjunction with or next to a directional pad onto a portable gaming device as taught by DeVolpi because it would allow for a variety of inputs to be used by a player.

Regarding claims 11, 12, Oshita, Tomizawa, Ku, and DeVolpi disclose the surface of the casing is a resin molded part, the resin molded part comprising a transparent window through which the display unit can be viewed and a frame other than the transparent window, the transparent window being made of a first transparent resin, the frame being made from a second colored resin **(Obvious since the portable electronic gaming devices as taught by the previous arts inherently teach that the casing is at least made up of a type of plastic, plastic being a type of resin. Any color combination of the resin would also be obvious.)**,

wherein the first resin and the second resin are molded in a unified fashion by two-color molding **(Obvious)**.

Regarding claim 13, Oshita, Tomizawa, Ku, and DeVolpi disclose the portable electronic device further comprising a speaker within the casing,

wherein a through hole is formed at the bottom face of the casing for emitting sounds generated from the speaker, the through hole being formed with an angle

toward the front face of the casing **(Obvious to anyone skilled in the art of gaming at the time of the invention that the electronic portable gaming devices of Oshita, Tomizawa, and Ku implement some kind of speaker within the device to emit sounds even though it isn't explicitly stated in the prior art. Applicant should be aware though of common portable gaming devices that do implement sound such as the well known GameBoy by Nintendo which was released on the market well before the filing date of this application.)**.

Regarding claim 14, Oshita, Tomizawa, Ku, and DeVolpi disclose a second through hole formed in the front face of the casing **(Obvious)**, and

a duct formed inside the casing for directing sounds generated from the speaker to the second through hole **(Obvious)**.

Regarding claim 15, Oshita, Tomizawa, Ku, and DeVolpi disclose a horizontally long housing, both end-of ends which is capable of being gripped by a user's both hands, respectively, **(Obvious. Oshita, Figure 4 clearly shows a person holding a portable electronic device with two hands)** and

a displaying unit fitted into the casing **(Obvious. Oshita, Figure 3, LCD Display 4)**,

wherein outer edge of each side of the casing is formed as arc shape fitting to the curve formed by a palm of the user gripping the casing **(Obvious. Looking at Oshita, Figures 2, 3, and 4, we can see bulges at the rear of the case which enables a person to place their fingers behind the portable electronic device.)**.,

wherein a horizontally longitudinal cross section of the casing has a gentle curve slanted from the center of the casing to the left or right hand of the user (**Obvious. Looking at Oshita, Figures 2, 3, and 4, we can see bulges at the rear of the case which enables a person to place their fingers behind the portable electronic device.**).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas K. Cheriyan whose telephone number is 571-270-3225. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/

Supervisory Patent Examiner, Art Unit 3714